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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,898	03/30/2001	Marion R. Rice	1011US06	7570

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,898

Applicant(s)

RICE ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-25 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenberg (U.S. 6,463,417) and further in view of Houser et al (U.S. 5,606,609).

As per claim 1, Schoenberg discloses a healthcare network comprising: a document database that stores at least one patient document (see column 4 line 52 through column 5 line 25), a web server communicatively coupled to the document database; a computer, communicatively coupled to the web server, running browser software used to review the at least one patient document; at least one web page, selectively delivered by the web server to the computer, that displays the at least one patient document (see column 4 lines 30-39).

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Schoenberg fails to disclose the documents having a digital signature when reviewing the documents and displaying at least an indication of the digital signature; and the computer responding to input via the at least one web page by at least causing generation of a watermark ID based on at least information regarding the signor.

However, Houser et al discloses the documents having a digital signature (see Fig. 9B) when reviewing the documents and displaying at least an indication of the digital signature (see column 13 lines 36-65 and Fig 7D); and the computer responding to input via the at least one web page by at least causing generation of a watermark ID based on at least information regarding the signor (see column 18 lines 57-67 where the watermark is described in column 16 lines 62-65).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Houser et al's digital signature and watermark in the electronic medical file system of Schoenberg.

Motivation to do so would have been to prevent forgery of the medical documents (see Houser et al column 1 line 55 through column 2 line 14).

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As per claim 2, the modified Schoenberg and Houser et al system teaches the generation of the watermark ID is based on information regarding the patient document (see Houser et al column 16 lines 62-65).

As per claim 3, the modified Schoenberg and Houser et al system teaches the digital signature comprises an electronic image signature (see Houser et al column 2 lines 1-14).

As per claim 4, the modified Schoenberg and Houser et al system teaches the network selectively verifying the authenticity of the patient document using the watermark ID (see Houser et al column 4 lines 47-60 where the display controller is part of the network).

As per claim 5, the modified Schoenberg and Houser et al system teaches the network selectively verifying the authenticity of the patient document using the watermark ID (see Houser et al column 4 lines 47-60 where the display controller is part of the network) and the digital signature (see Houser et al column 3 line 61 through column 4 line 2).

As per claim 6, the modified Schoenberg and Houser et al system teaches the computer responding to input via the at least one web page by causing merger of the watermark ID

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with the digital signature (see Houser et al column 5 lines 59-60).

As per claim 7, the modified Schoenberg and Houser et al system teaches the computer displaying the watermark ID with or without the digital signature (see Houser et al column 5 lines 59-60).

As per claim 8, the modified Schoenberg and Houser et al system teaches the watermark ID comprising a barcode (see Houser et al column 18 lines 57-67).

As per claim 9, the modified Schoenberg and Houser et al system teaches the computer responding to input via the at least one web page by at least causing association of a watermark ID with a document (see Houser et al column 18 lines 57-67 where it is inherent that when the watermark is printed on the document it is associated with that document).

As per claim 10, the modified Schoenberg and Houser et al system teaches the computer responding to input via the at least one web page by at least causing, using the at least an indication of the digital signature, an electronic image signature to be obtained from a database (see Houser et al column 10 lines 39-51).

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As per claim 11, the modified Schoenberg and Houser et al system teaches a method of verifying the authenticity of a patient document in a healthcare network comprising: retrieving a patient document from a document database (see Schoenberg column 4 line 52 through column 5 line 25) having a digital signature of a signor (see Houser et al Fig 9B); generating a watermark ID based on at least information regarding the signor; and displaying the watermark ID on a screen for review (see Houser et al column 17 lines 5-13).

As per claim 12, the modified Schoenberg and Houser et al system teaches the generation of the watermark ID is based on information regarding the patient document (see Houser et al column 16 lines 62-65).

As per claim 13, the modified Schoenberg and Houser et al system teaches the digital signature comprises an electronic image signature (see Houser et al column 2 lines 1-14).

As per claim 14, the modified Schoenberg and Houser et al system teaches merging the watermark ID with the digital signature (see Houser et al column 5 lines 59-60).

As per claim 15, the modified Schoenberg and Houser et al system teaches the computer displaying the watermark ID

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with the digital signature (see Houser et al column 5 lines 59-60).

As per claim 16, the modified Schoenberg and Houser et al system teaches the watermark ID comprising a barcode (see Houser et al column 18 lines 57-67).

As per claim 17, the modified Schoenberg and Houser et al system teaches associating the watermark ID with a document (see Houser et al column 18 lines 57-67 where it is inherent that when the watermark is printed on the document it is associated with that document).

As per claim 18, the modified Schoenberg and Houser et al system teaches an electronic image signature to be obtained from a database (see Houser et al column 10 lines 39-51).

As per claim 19, the modified Schoenberg and Houser et al system teaches a patient management system comprising: a user interface (see Schoenberg column 4 lines 30-39 where the browser is a user interface); a patient document that has a digital signature of a signor (see Houser et al Fig 9B); and a processor that responds to the user interface by generating a watermark ID using at least information regarding the signor (see Houser et al column 18 lines 57-67).

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As per claim 20, the modified Schoenberg and Houser et al system teaches the generation of the watermark ID is based on information regarding the patient document (see Houser et al column 16 lines 62-65).

As per claim 21, the modified Schoenberg and Houser et al system teaches the digital signature comprises an electronic image signature (see Houser et al column 2 lines 1-14).

As per claim 22, the modified Schoenberg and Houser et al system teaches merging the watermark ID with the digital signature (see Houser et al column 5 lines 59-60).

As per claim 23, the modified Schoenberg and Houser et al system teaches the computer displaying the watermark ID with the digital signature (see Houser et al column 5 lines 59-60).

As per claim 24, the modified Schoenberg and Houser et al system teaches the watermark ID comprising a barcode (see Houser et al column 18 lines 57-67).

As per claim 25, the modified Schoenberg and Houser et al system teaches associating the watermark ID with a document (see Houser et al column 18 lines 57-67 where it is inherent that when the watermark is printed on the document it is associated with that document).

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Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Campbell et al (U.S. 6,047,259) discloses a medical document system with the use of digital signatures, Bessette (U.S. 6,263,330) discloses a method and apparatus for managing medical records, and Hoffman et al (U.S. 5,613,012) discloses the use of an electronic signature database.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

Andrew Caldwell
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